REMARKS

The Applicants have carefully studied the outstanding Office Action. The present response is intended to be fully responsive to the rejection raised by the Office and is believed to place the application in condition for allowance. Further, the Applicants do not acquiesce to any of the Office's rejections not particularly addressed. Favorable reconsideration and allowance of the application is respectfully requested.

Application Status

The application includes 23 claims, including independent claims 1, 8, and 17. The Applicants thank the Office for noting that each of the claims 5, 6, 13, 14, 22, and 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the elements of such base claim and any intervening claims. The Office rejected the remaining claims under 35 U.S.C. § 103(a). In particular, the Office rejected claims 1-4, 8-9, 12, 15-18 and 21 based on US Patent 6,141,488 (*Knudson*) in combination with the Examiners Official Notice of existing prior art, and claims 7, 10-11, 19, and 20 stand rejected based on the combination of Knudson and US Patent 5,682,206 (*Wehmeyer*).

The Applicants have amended independent claims 8 and 17. In view of the foregoing amendments and the following arguments, the Applicants respectfully submit that claims 1-23 are allowable. Thus, the Applicants request that the application be passed to issue.

Rejection under 35 U.S.C. § 103(a) and Response Thereto

As noted above, the Office rejected claims 1-4, 8-9, 12, 15-18 and 21as being unpatenable over *Knudson* in view of the Office's Official Notice. The Office stated that Knudson "fails to disclose from the beginning playing the recorded data starting with the data recorded at the scheduled start time."

In taking Official Notice, the Office stated "that it is well known, that user can provide a time parameter to search for a starting point to reproduce from, as is well known to those skilled in the art, allowing for a user specified starting points for reproduction." The Office also stated that "[t]herefore, it would have been obvious to one skilled in the art at the time the invention to modify Knudson by incorporating a user input means to dictate a start of reproduction time, therefore, obvious the user can select 3:00, based on the scheduled start time, thereby allowing and providing a means to a user to select, a start time as desired using a time parameters, as is obvious to those skilled in the art."

A. Challenge of Official Notice

The Applicant respectfully challenges the taking of Official Notice. Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings **will not support** an obviousness rejection) (emphasis added). The Applicants emphatically disagree with the contention that the record contains specific factual findings and concrete evidence to support that it is known "at the time the invention was made to modify Knudson by incorporating a user input means to dictate a start of reproduction time ..." The Applicants submit that there are no specific factual findings and concrete evidence in the record relating to the claim element: "responsive to a command to play the recorded data from a beginning, playing the recorded data starting with data recorded at the scheduled start time."

Nonetheless, the Applicants submit that despite the lack of specific factual findings or concrete evidence to support the obviousness rejection, the combination of *Knudson* and the Office's Official Notice fail to establish a *prima facie* case of obviousness for the presently claimed invention. According to M.P.E.P. § 2143, in order to establish the required *prima facie* case of obviousness of a claimed invention by applying a combination of references, the proposed combination must teach or suggest all of the elements of the claimed invention.

B. The Proposed Combination Does Not Teach All the Elements

The Applicants submit that neither the *Knudson* nor the Office's Official Notice expressly or impliedly teach or suggest all the elements of the pending claims. Specifically, the Applicants submit that (1) the *Knudson* does not disclose explicitly or inherently the claimed element "responsive to a command to play the recorded data from a beginning, playing the recorded data starting with data recorded at the scheduled start time" and (2) the Office's Official Notice likewise fails to disclose such subject matter. The Applicants submit that these references either alone or combined, fail to disclose or suggest, all of the claimed elements. In particular, the Office's Official Notice assumes a user enters a particular time parameter to indicate from where the reproduction, or playback should be initiated. Claim 1, however, states that the "command to play the recorded data from a beginning" is interpreted to initiate playback from a predetermined time (the "scheduled start time") that is other than the actual beginning of the recorded material. Thus, the claim cannot be rendered

obvious by a system that contains a parameter indicative of the time from which the playback should be initiated, as is the case for the Office's Official Notice prior art.

Consequently, the Applicants respectfully submit that the Office failed to raise a *prima facie* case of obviousness with respect to the pending claims. Since the dependent claims necessarily include the elements of the independent claims from which they depend, each of the dependent claims includes the above-listed elements of the independent claims from which they depend. Thus, the Applicants submit that the Office failed to raise a *prima facie* case of obviousness with respect to the dependent claims 2-7 for the same reasons.

Applicants have amended the other independent claims 8 and 17 to track the cited language of claim 1. Specifically, the language "to play the recorded data from the beginning" has been added. Applicants therefore submit that all pending claims are therefore allowable.

CONCLUSION

The Applicants submit that the application is in good and proper form for allowance and respectfully request the Office to pass this application to issue. If, in the opinion of the Office, a telephone conference would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney, at 312-913-3305.

Respectfully submitted,
McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP

Date: 12/5/05

By: _____
Robert J. Irvine III
Registration No. 41,865